

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TONY WESTMAN
and ANNE NARHI

Appeal No. 1998-1394
Application No. 08/325,448

ON BRIEF

Before THOMAS, HAIRSTON, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 1-20. We reverse.

BACKGROUND

The invention at issue in this appeal is used to track a movable object, such as a bag of registered money or mail. More specifically, the invention is a lightweight, mobile

transponder. Components of the transponder include an antenna, a paging receiver, a transmitter, and a power supply. Using a conventional paging network to control the transponder ensures good coverage and saves the cost of building and operating a new communications network. Control data sent to the transponder define the frequency, power, and sequences of the transmitter.

Claim 1, which is representative for our purposes, follows:

1. A transponder system (B) for localization of an object being provided with a transponder for this system comprising antenna device and a paging receiver (1) having an unique call, further comprising
 - a built-in marker transmitter (10) having a standby mode, and a working enabling mode during which said marker transmitter (10) is working on a fixed frequency different from the frequency of the paging receiver (1),
 - a unit (2) for decoding of an authorization code and a control information obtained via the paging receiver (1),
 - an electronic logic unit (3) for processing of control information obtained from the decoder (2),
 - a power supply (11) to permit the transponder system (B) and its marker transmitter (10) to operate during a certain minimum time period during the enabling mode, and

that operation of the marker transmitter (10) during the enabling mode is controlled by the logic unit (3) based on remotely transmitted control information obtained from the paging receiver (1) via the unit (2) for decoding.

The references relied on in rejecting the claims follow:

Rackley	4,742,357	May 3, 1988
Borras	5,128,938	Jul. 7, 1992 (filing Mar. 6, 1991)
Wohl et al. (Wohl)	5,247,700	Sep. 21, 1993 (filing Nov. 16, 1990)
Hatano et al. (Hatano)	5,355,511	Oct. 11, 1994 (filing Aug. 7, 1991).

Claims 1-13, 15, and 17-20 stand rejected under 35 U.S.C. § 103(a) as obvious over Rackley in view of Wohl and Borras. Claims 6, 14, and 16 stand rejected under 35 U.S.C. § 103(a) as obvious over Rackley in view of Wohl and Borras further in view of Hatano. Rather than repeat the arguments of the appellants or examiner in toto, we refer the reader to the brief and answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejections advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 1-20. Accordingly, we reverse.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With these in mind, we consider the appellants' argument and the examiner's reply.

The appellants argue, "none of the references describe or suggest enabling a marker transmitter based upon control information obtained from a paging receiver." The examiner replies, "Wohl discloses a transponder (a cellular telephone with pager) system comprising a paging network which communicates a transponder with a paging frequency, and the transponder transmits a frequency different from the paging network's frequency (col. 1, lines 24-45)." (Examiner's Answer at 5.)

"[T]he main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. [T]he name of the game is the claim'" In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright

L. 497, 499, 501 (1990)). Here, claims 1-20 each specify in pertinent part the following limitations:

operation of the marker transmitter (10) during the enabling mode is controlled by the logic unit (3) based on remotely transmitted control information obtained from the paging receiver (1) via the unit (2) for decoding.

In short, the claims each recite using a paging receiver to receive transmitter controlling data.

The examiner fails to show a teaching or suggestion of the claimed limitation. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996) (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,

1127 (Fed. Cir. 1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." Id. at 1266, 23 USPQ2d at 1784, (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Here, the examiner admits, "Rackley does not explicitly recite ... a paging network communicates a transponder with a paging frequency which is different from the transponder's transmitted frequency." (Examiner's Answer at 5.) This is an understatement. The reference does not disclose using a paging receiver for any purpose, let alone for receiving transmitter controlling data. Rackley merely mentions, "a receiver **12** responsive to the message sent by base station **30**" Col. 6, ll. 48-50.¹

¹Although the reference teaches receiving a transmitter controlling message, col. 3, ll. 58-63, the message is not received by a paging receiver.

For its part, Wohl teaches a paging receiver 18. Col. 3, 1. 2. The paging receiver, however, is not used to receive controlling data of any sort, let alone transmitter controlling data. To the contrary, the paging receiver 18 merely receives a "paging signal" Col. 2, l. 13. The paging signal is a "telephone number," col. 1, l. 34, rather than controlling data.

The examiner fails to allege, let alone show, that Borrás or Hatano remedies the defects of Rackley and Wohl. Because the references do not teach using a paging receiver to receive controlling information of any sort, we are not persuaded that teachings from the prior art would appear to have suggested the claimed limitation of using a paging receiver to receive transmitter controlling data. The examiner has impermissibly relied on the appellants' teachings or suggestions; he has not established a prima facie case of obviousness. Therefore, we reverse the rejections of claims 1-20 under 35 U.S.C. § 103(a).

CONCLUSION

To summarize, the rejection of claims 1-20 under 35
U.S.C. § 103(a) is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
KENNETH W. HAIRSTON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LANCE LEONARD BARRY)	
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